

REMARKS

In response to the Final Office Action¹ mailed September 6, 2007, Applicant respectfully requests reconsideration. Upon entry of this amendment, claims 1-15, 20-29, 32-34, and 40-43 are pending in the application of which claims 1, 21, 40, and 42 are independent. Applicant notes that the application as-filed did not include a claim numbered 29, but that certain claims (claims 32 and 33) in the application as-filed were identified as depending directly or indirectly from claim 29. Therefore, Applicant has provided a claim 29, and labeled it as new claim.

Also, by this amendment Applicant amends claim 21 to correct a grammatical error, amends claims 21-28 and 32-34 to make their preambles consistent, and cancels claims 16-20, 30, 31, and 35-39 without prejudice or disclaimer. Finally, by this amendment, Applicant amends claims 40-43 and paragraph [0050] of the Specification to remove references to “a carrier wave” and references to tangibility. Accordingly, no new matter is introduced by these amendments.

I. Rejections under 35 U.S.C. § 101

In the Office Action, claims 40-43 are rejected under 35 U.S.C. § 101 as “not [being] limited to tangible embodiments.” Final Office Action at 2 and 3. Applicant is aware of the recent Federal Circuit decision that a signal embodied in a carrier wave does not comprise statutory subject matter. See *In re Nuijten*, No. 06-1371 (Fed. Cir. Sept. 20, 2007). Due to the current state of the law regarding statutory subject matter, Applicant has amended the specification and dependent claims 41 and 43 to eliminate the recitation of “a carrier wave.” Accordingly, Applicant respectfully requests reconsideration and the withdrawal of the rejections under 35 U.S.C. § 101. Similarly, by amendment of paragraph [0050] of the specification, Applicant has excluded “a carrier wave” from the scope of the independent claims 40 and 42.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

II. Rejections under 35 U.S.C. § 103

In the Office Action, claims 1-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0083344 ("*Vairavan*") in view of U.S. Patent No. 7,017,186 ("*Day*"). See Final Office Action at 4. Of the rejected claims, claims 1, 21, 40, and 42 are independent. Applicant notes, however, that, pursuant to 35 U.S.C. § 102(e), the earliest prior art date of *Day* is July 30, 2002.

Applicant disagrees with and traverses the rejection under 35 U.S.C. § 103(a). In the form of the Declarations Under 37 C.F.R. § 1.131, Applicant provides evidence that the claimed invention was conceived before the relevant, effective date of *Day* (July 30, 2002) and that diligence toward reduction to practice was applied until the filing date of the instant application. Since *Day* does not qualify as prior art in view of the Declarations, the rejections under 35 U.S.C. § 103, all of which rely on *Day*, should be withdrawn.

A. Declaration A establishes the inventors' possession of at least the independent claims prior to *Day*.

To expedite examination, Applicant submits herewith the Declaration Under 37 C.F.R. § 1.131 ("Declaration A") by all of the named inventors, which, pursuant to 37 C.F.R. § 1.131, establishes a conception, before July 30, 2002, of the invention disclosed in U.S. provisional patent application Serial No. 60/402,255, upon which this application is based. See Declaration A. The Declaration also establishes diligence in achieving reduction to practice of the invention for the period between prior to July 30, 2002 and the filing of USSN 60/402,255 on August 9, 2002.

Applicant thanks the Examiner for acknowledging, "The Declaration [filed on June 21, 2007] provides a sufficient showing that the inventor(s) conceived the invention claimed in the independent claims." See Final Office Action at 3. The Examiner objected to the Declaration for having only one of the named inventors' signatures. See Final Office Action at 3.

Declaration A is similar to the previously submitted Declaration, but Declaration A references and is signed by both of the named inventors on the application, namely Mr. Lobo and Mr. Singhal. Therefore, with the submission of Declaration A, it is respectfully submitted that *Day* is not available as prior art against at least the independent claims (claims 1, 21, 40, and 42), and that the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn. See C.F.R. § 1.131(a)-(b).

B. Declaration A also establishes the inventors' possession of many of the dependent claims prior to *Day*.

In the Final Office Action, the Declaration filed on June 21, 2007 was objected to as failing "to establish possession for all the species enumerated in the dependent claims." See Final Office Action at 3. Applicant respectfully submits that Declaration A also establishes possession of the invention as enumerated in the dependent claims (at least claims 2, 5-7, 15, 24-27, 41 and 43). These claims recite elements of embodiments of the systems, methods and devices recited in the independent claims, and therefore, an additional showing is not necessary. See M.P.E.P. § 715.02 (II) Rev. 6, Sept. 2007 (noting that a reference may be antedated by a declaration under 37 CFR 1.131 showing a completion of the invention of only a single species and citing to *In re Defano*, 392 F.2d 280, which distinguishes species from embodiments of a single invention).

In view of Declaration A submitted herewith, it is respectfully submitted that *Day* is also not available as prior art against at least claims 2, 5-7, 15, 24-27, 41 and 43, and that the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn. See C.F.R. § 1.131(a)-(b).

C. Declaration B establishes the inventors' possession of many of the dependent claims prior to *Day*.

To expedite examination, Applicant also submits herewith a Second Declaration Under 37 C.F.R. § 1.131 ("Declaration B") by all of the named inventors, which establishes a

conception, before July 30, 2002, of the invention disclosed in U.S. provisional patent application Serial No. 60/402,255 (the “255 Provisional”), and claimed in this application, which claims priority to the ‘255 Provisional. See Declaration B. Declaration B also establishes diligence in achieving reduction to practice of the invention for the period between prior to July 30, 2002 and the filing of the ‘255 Provisional on August 9, 2002. Specifically, Declaration B addresses the subject matter recited in dependent claims 3-4, 8-14, 22-23, 28, 29 and 32-34.

As stated in Declaration B, the inventors, Mr. Lobo and Mr. Singhal, conceived of the invention enumerated in the above-cited claims prior to July 30, 2002. See Declaration B, paras. 6-7. The conception is evidenced by the preparation, in the U.S., of computer software code implementing the claimed invention before July 30, 2002. The implementation of the computer software code is documented in Exhibits A-R attached to Declaration A and B.

In addition to conceiving the invention and personally working toward its reduction to practice prior to July 30, 2002, the inventors exercised diligence in reducing the invention to practice by starting a patent application drafting project. The project resulted in the filing on August 9, 2002, of the ‘255 Provisional. The filing of the ‘255 Provisional constitutes constructive reduction to practice of the invention claimed in the instant application. Declaration B conclusively shows that diligence was exercised in achieving the constructive reduction to practice of the invention enumerated in the above-cited claims in the period from before the effective filing date of *Day* (July 30, 2002) to the filing date of the ‘255 Provisional (August 9, 2002). See Declaration B, generally.

In view of Declaration B submitted herewith, Applicant respectfully submits that *Day* is also not available as prior art against at least claims 3-4, 8-14, 22-23, 28, 29 and 32-34, and that the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn. See C.F.R. § 1.131(a)-(b).

Conclusion

In view of the foregoing response and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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